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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,913	01/15/2002	James Patrick Goodwin	23452-506	4962

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EXAMINER
STORK, KYLE R

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/044,913	GOODWIN ET AL.
Examiner	Art Unit	
Kyle R Stork	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 15 January 2002.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
*Paper No(s)/Mail Date 10 August 2004*

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This office action is in response to the application filed 15 January 2002 and the Information Disclosure Statement filed 10 August 2004.
2. Claims 1-20 are pending. Claims 1, 6, 11, and 16 are independent.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 10 August 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per dependent claim 10, the applicant discloses, "the system of claim 1..." However, claim 1 is directed toward a method. This renders claim 10 indefinite.

### ***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-4, 6-9, and 11-19 rejected under 35 U.S.C. 102(a) as being anticipated by Shanahan et al. (EP 1143356, 2001).

As per independent claim 1, Shanahan discloses a method for using extensible markup language to normalize documents, the method comprising the steps of:

- Determining a type of object repository storing at least one object, the object comprising metadata (paragraph 003; paragraphs 008-009)
- Identifying the at least one object stored in the at least one object repository (paragraph 0022; paragraph 0027)
- Extracting at least one portion of the at least one object, wherein the at least one portion is extracted in extensible markup language (XML) format (Figure 4; paragraph 0020; paragraph 0027)
- Transmitting the at least one portion to a processor (paragraph 0022; paragraph 0027)
- Processing the at least one portion (paragraph 0022; paragraph 0027)

As per dependent claim 2, Shanahan discloses the method wherein some of the metadata is preserved (paragraph 0015: Here, the ability to maintain and expand on the meta-data is processing).

As per dependent claim 3, Shanahan discloses the method wherein the metadata that is preserved includes at least one of author, title, subject, date created, date modified, list of modifiers, and link list information (paragraph 0015).

As per dependent claim 4, Shanahan discloses the method further comprising the step of mapping at least one field in the at least one object with a field designation

identifier (paragraph 0021: Here, the data is mapped to tags such as <MYNAME> and <WANT>).

As per independent claim 6, the applicant discloses the system for execution of the method of claim 1. Claim 6 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 1.

As per dependent claim 7, the applicant discloses the system for execution of the method of claim 2. Claim 7 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 2.

As per dependent claim 8, the applicant discloses the system for execution of the method of claim 3. Claim 8 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 3.

As per dependent claim 9, the applicant discloses the system for execution of the method of claim 4. Claim 9 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 4.

As per independent claim 11, the applicant discloses the system for execution of the method of claim 1. Claim 11 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 1.

As per dependent claim 12, the applicant discloses the system for execution of the method of claim 2. Claim 12 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 2.

As per dependent claim 13, the applicant discloses the system for execution of the method of claim 3. Claim 13 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 3.

As per dependent claim 14, the applicant discloses the system for execution of the method of claim 4. Claim 14 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 4.

As per independent claim 15, Shanahan discloses the system wherein the processing means comprises at least one of a means for full-text indexing the at least one object, means for extracting metrics information from the at least one object, and means for categorizing the at least one object (paragraphs 0021-0026: Here, the information can be extracted, and changed and have additional information added).

As per independent claim 16, the applicant discloses the processor readable medium comprising processor readable code for execution of the method of claim 1. Claim 16 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 1.

As per dependent claim 17, the applicant discloses the processor readable medium comprising processor readable code for execution of the method of claim 2. Claim 17 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 2.

As per dependent claim 18, the applicant discloses the processor readable medium comprising processor readable code for execution of the method of claim 3.

Claim 18 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 3.

As per dependent claim 19, the applicant discloses the processor readable medium comprising processor readable code for execution of the method of claim 4.

Claim 19 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 4.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 10, and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan in further view of Summerlin et al. (US 6553365, 2003)

As per dependent claim 5, Shanahan discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Shanahan fails to specifically disclose the method wherein the processor comprises at least one of a full-text engine, a metrics engine, and a taxonomy engine. Summerlin discloses the method wherein the processor comprises at least one of a full-text engine, a metrics engine, and a taxonomy engine (Figure 6; column 12, lines 16-20: Here, the taxonomy engine searches the database).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Shanahan's method of using a metadata repository with Summerlin's taxonomy engine, since it would have allowed a user to search a metadata repository for information.

As per dependent claim 10, the applicant discloses the system for execution of the method of claim 5. Claim 10 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 5.

As per dependent claim 20, the applicant discloses the processor readable medium comprising processor readable code for execution of the method of claim 5. Claim 20 is subsequently rejected under Shanahan for disclosing information similar to that discloses in claim 5.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Bax et al. US 20040205548A1: Discloses extracting data from structured documents.
- Dean et al. US 20020152244A1: Discloses creating document type definitions.
- Fittges et al. US006754648B1: Discloses storing and managing data.
- Alexander US006732331B1: Discloses tag-delimited templates using metadata.
- Ballantyne et al. US006687873B1: Discloses reporting XML data.

- Lippert et al. US006626957B1: Discloses markup language and content mapping.
- Saito et al. US006353840B2: Discloses extracting information from documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 2178



STEPHEN S. HONG  
PRIMARY EXAMINER